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EXAMINER

KYLE, CHARLES R

ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/676,248

Applicant(s)

MAESTLE, WILFRIED A.

Examiner

Charles Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-78 and 80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49,51-53,55-78 and 80 is/are rejected.
- 7) ☒ Claim(s) 50, 54 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 49 is provisionally rejected under the judicially created doctrine of double patenting over claim 1 of copending Application No. 09/781964. Although the Claims are not identical, they are not patentably distinct from each other because they recite, *inter alia*, a computer usable medium having computer-readable program code embodied in a medium for generating financial statements, financial data, charts, graphs and reports using the standard project finance tools, the product having means for providing limited recourse including debt service reserve accounts, stand-by loans and risk-sharing with suppliers and of-takers; means for allowing automatically generated or manual entry of and editing of capital expenditure time series for multiple contracts in multiple capital expenditure categories; means for selecting a desired financing time horizon for each loan; means for setting for each loan a percentage of a capital expenditure time series to be financed; means for automatically generating a loan disbursement time series and means for generating a loan disbursement times series independent of changes in capital expenditures and exchange rates based upon an earlier automatically

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generated loan disbursement time series. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 49-78 and 80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Claims begin with the word “Method. The article “A” should precede the Claim language.

The Claims recite “the standard project finance tools” twice, at least. The phrase lacks antecedent basis. As well, one of ordinary skill in the financial arts would be hard put to identify “the standard project finance tools”. Such tools are broad, varied and constantly changing and have no regulatory authority for standardization.

The Claims recite “permitting entry of data representative of multiple contracts...” There is no positive recitation that the entry of data is actually done and the recited step is not considered limiting.

The Claims recite that a “loan disbursement time series” is generated. A thorough review of the Specification provides no understanding of what constitutes a “loan disbursement time series.” The phrase does not appear in the Specification and a review of all references to “disbursement” and “series” provide no clarification. For purposes of examination, it is assumed

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that this concept is very similar or identical to the recited “disbursement schedule.” The use throughout the Claims of the phrase “time series” is confusing because the concept is either redundant or not clearly explained in the Specification. It is unclear whether such a series is a schedule, table or some other organization of information related to time. Clarification is required.

The Claims also recite the phrase “a capital expenditure time series” which is not clear from the Claim language or Specification.

Additionally, for purposes of examination, the phrase “disbursement schedule” is interpreted to constitute a schedule of disbursements to pay off a loan. The Claim language does not distinguish over this interpretation.

Claim 50 recites that expenditure categories “can” serve as a basis for loan financing, etc. There is no clear recitation that they do so serve.

Claims 54, 55, 57 recite steps where an activity is “allowed” with no positive recitation that the step is actually performed. **Claim 54** also contains two doubled hyphens, which are clumsy.

Claim 63 recites a step where an activity is “permitted” with no positive recitation that the step is actually performed; the recited step is not considered limiting.

With respect to Claim 56, it recite the phrase “cash flow income statement”. This particular statement is unknown to the Examiner, who worked as an accountant for nine years; it does not appear in the prior art of record.

Claim 78 recites that capacity use time series is revisited only to the extent that a user’s intentions cannot be inferred. One of ordinary skill in financial planning arts would not know

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how the metes and bounds of the claim are delineated, given this phrasing. The Claim also recites "permitting" which does not clearly require change of a startup date.

Claims 75-78 and 80 all depend directly or indirectly from Claim 1, which is cancelled.

Examination has been done to the best of the Examiner's ability given the condition of the Claims.

Regarding Applicant's comments in the Supplemental Response of June 2, 2005 on the 35 USC 112 2nd rejections, they consist of assertions that such features are well known in the art; they do not provide evidence to show an industry standardization or provide explanation of how one would delineate the metes and bounds of the claims..

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 49, 51-53, 55-56, 58, 60-61, 63, 66-69, 73-74, 76-77 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2005/0182709 *Belcsak* in view of US 5,704,045 *King et al.*

Regarding Claim 49, *Belcsak* discloses the invention substantially as claimed, including in a method for implementing a machine-readable financial simulation computer program

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product (Abstract; para. 63) for creating a project preparation (paras. 126, 218), negotiating (para. 78) and testing (paras. 189-196) environment using project finance tools, steps of:

installing the program which is contained as computer readable code on a computer usable medium (Fig. 1; paras. 45-59) for generating financial statements, financial data (paras. 120-121), charts, graphs (Figs. 16-17 and related text) and reports using project finance tools (para 121);

entry and editing of data (para. 10) representative of multiple contracts (para. 248) and multiple capital expenditure categories (para. 136);

selecting a desired loan financing time horizon (paras. 128-129);

setting a percentage of a capital expenditure time series to be financed (understood to be 100% of loan); and

generating a loan disbursement time series independent of changes in capital expenditures and exchange rates based on an earlier automatically generated disbursement time series (Figs. 26, 27; para. 216)

In the treatment of the next to last phrase quoted above regarding a percentage of capital expenditure time series to be financed, it is understood that *Belcsak* discloses setting percentage at 100%. Further, the last phrase is broadly and reasonably interpreted as the generation of a plurality of completely independent loan disbursement time series. The Claim language specifically makes the two time series disjoint; this is disclosed by *Belcsak* as a simple plurality of such time series.

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Belcsak does not specifically disclose inclusion of limited recourse including the recited debt service reserve accounts and risk sharing features. *King* discloses these limitations at Summary of the Invention (reserve accounts and insurance) in connection with a loan (mortgage, Col. 4, lines 11-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the financial simulation method of *Belcsak* to include the limited recourse tools of *King* because this would provide elements to reduce risk associated with simulated loans.

With respect to Claim 51, *Belcsak* discloses manual redesign of individual repayment amounts at para. 120. Also, Official Notice is taken that it was old and well known to prohibit paying off a loan early. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Belcsak* with this provision because this would provide a predictable revenue stream to the lender.

Concerning Claim 52, Official Notice is taken that it is old and well known to provide convertibility of funds in complex projects so as to provide for transactions with entities in foreign nations.

Concerning Claim 53, Official Notice is taken that it is old and well known for a company to build inventories. For example, a company anticipating an increase in sales would build inventories to meet future demand. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Belcsak* to build inventories because this would account for inventory effects in business financial simulation.

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Concerning Claim 55, *Belcsak* discloses selection of a time to produce a unit at paras. 153-162.

As to Claim 56, Official Notice is taken that an income statement for a period and a balance sheet prepared at the end of the period would inherently account for output variations including maintenance shutdowns. For example, shutdowns would reduce revenues and so net income. Equity in the balance sheet would reflect reduced net income. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Belcsak* to include financial statements reflecting output variations because this would give owners a clear understanding of financial performance over a fiscal period.

With respect to Claims 58 and 60, *Belcsak* discloses variables related to products at Summary of the Invention, at least.

With respect to Claim 61, *Belcsak* discloses different product sales contract types at paras 135-162.

With respect to Claim 63, prepayment of loans is old and well known in financial arts.

With respect to Claims 66 and 67, Official Notice is taken that investment and maintenance expense accounts are old and well known in accounting and financial arts. For example, a company wishing to preserve or improve its capital investment must provide funds for such activities and establish appropriate, accounts/categories. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Belcsak* to include such accounts/categories because this would facilitate maintenance and improvement of assets.

Concerning Claim 68, *Belcsak* does not specifically disclose various learning curves reflecting “learning curve” experience in startup of a business. Official Notice is taken that it

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was old and well known to account for such a phenomenon. For example, one skilled in business simulation would recognize that new workers gradually improve job performance with experience. Thus, a worker would become more productive with experience at startup. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Belcsak* to account for such startup curves because this would give a more realistic estimate of startup projection as opposed to merely assuming that a new worker would be 100% productive from the beginning of work.

With respect to Claim 69, it recites updating various financial known measurements based on newly entered data. Such updating is necessary to fairly represent new financial conditions.

With respect to Claims 73 and 77, *Belcsak* does not specifically disclose financial statements as claimed. Official Notice is taken that such statements are old and well known in accounting. For example, the Examiner has prepared such statements to apprise management of the financial condition of companies. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Belcsak* to produce such statements to provide decision makers with a timely understanding of a company's financial position.

With respect to Claim 74, see the discussion of Claims 68 and 69.

With respect to Claim 76, *Belcsak* discloses an option to change input time periods at para. 216, various date parameters recited.

With respect to Claim 80, *Belcsak* discloses GUIs at Figs 5-12, at least.

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Claims 57, 59, 62, 64, 71 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over 2005/0182709 *Belcsak* in view of US 5,704,045 *King et al* and further in view of *Dictionary of Finance and Investment Terms*.

With respect to Claim 57, *Belcsak* discloses the invention substantially as claimed. See the discussion of Claim 49. *Belcsak* does not specifically disclose a cost-plus contract. *Dictionary* discloses this limitation at page 124. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Belcsak* to consider cost-plus contracts because this would provide suppliers a way to eliminate losses on a contract with no precedent, as disclosed by *Dictionary*.

With respect to Claim 59, *Belcsak* discloses the invention substantially as claimed. See the discussion of Claim 49. *Belcsak* does not specifically disclose equity subscription. *Dictionary* discloses this limitation at page 430. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Belcsak* to include monthly and month-to-month equity subscriptions to increase funds available to the company.

With respect to Claim 62, *Belcsak* discloses the invention substantially as claimed. See the discussion of Claim 49. *Belcsak* does not specifically disclose break even testing of a contract for a product. *Dictionary* discloses this limitation at page 66. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Belcsak* to include break even testing to distinguish profitable for unprofitable contracts.

With respect to Claim 64, *Belcsak* discloses the invention substantially as claimed. See the discussion of Claim 49. *Belcsak* does not specifically disclose debt service reserve accounts. *Dictionary* discloses this limitation at page 138. It would have been obvious to one of ordinary

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skill in the art at the time of the invention to modify *Belcsak* to include such coverage, including adjusting step-ups to adequately meet principal and interest payments on debt.

With respect to Claim 71, see the discussion of Claim 62.

With respect to Claim 78, see the discussion of Claims 71 and 74.

Claims 65 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2005/0182709 *Belcsak* in view of US 5,704,045 *King et al* and further in view of *College Accounting, Seventh Edition*.

With respect to Claim 65, *Belcsak* discloses the invention substantially as claimed. See the discussion of Claim 49. *Belcsak* does not specifically disclose depreciation of capital assets over a period. *College Accounting* discloses this limitation at pages 624-625. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Belcsak* to include such depreciation to fairly represent on financial statements the expense related to the utilization of these assets.

With respect to Claim 70, Official Notice is taken that automatic and manual recording of corporate and property tax data was old and well known at the time of the invention. For example, such taxes payable accounts were used to record liabilities to tax authorities. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Belcsak* to account for tax accounts because this would comply with generally accepted accounting principles.

The use of the phrase "...tax rate time series" is exemplary of the difficulty caused by the time series phrasing. It is unclear what constitutes such a series and the Specification provides no insight.

Claims 72 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2005/0182709 *Belcsak* in view of US 5,704,045 *King et al* and further in view of *Access 97 Bible*.

With respect to **Claims 72 and 75**, *Belcsak* discloses the invention substantially as claimed. See the discussion of Claim 49. *Belcsak* does not specifically validation during input of data. *Access 97 Bible Accounting* discloses this limitation at pages 539-539. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Belcsak* to include such validation to quickly and accurately correct input data.

Allowable Subject Matter

Claims 50 and 54 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection, or alternatively are addressed above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (571) 272-6746. The examiner can normally be reached on 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

crk
September 2, 2005

Examiner Charles Kyle

A handwritten signature in black ink, appearing to read "Charles Kyle", with a stylized flourish at the end.